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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/023,887	12/21/2001	Keith Alexander Harrison	30003064-2	5605

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EXAMINER

WILLIAMS, JEFFERY L

ART UNIT

PAPER NUMBER

2137

DATE MAILED: 11/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/023,887

Applicant(s)

HARRISON, KEITH ALEXANDER

Examiner

Jeffery Williams

Art Unit

2137

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

This action is in response to the communication filed on 9/12/05.

All objections and rejections not set forth below have been withdrawn.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1 – 10, 13 – 26, 29 – 42, 45, and 46 are rejected under 35 U.S.C. 102(b) as being anticipated by Khello, “Method and Apparatus for User Authentication”, U.S. Patent 5,724,423.

Regarding claim 17, Khello discloses:

a personal communication device, the personal communication device comprising a memory in which is stored a secret (Khello, fig. 3; elems. 29, 34; col. 2,

Art Unit: 2137

line 63 – col. 3, line 11; col. 8, lines 27-46). Khello discloses the use of memory to store secrets such as a user PIN, encoding keys, and secret encoding algorithms.

and a digital device capable of communication with the personal communication device (Khello, fig. 4),

the personal communication device being configured whereby upon the digital device requesting a secret from the personal communication device, the personal communication device requests confirmation from a user that the secret can be provided and provides the secret to the digital device only if the confirmation is provided by the user (Khello, col. 1, lines 26-32; col. 6, lines 5-30).

Regarding claim 18, Khello discloses:

in which the communication capable of being established between the personal communication device and the digital device is wireless communication (Khello, col. 5, lines 46 – 65). Khello discloses that users may access services using a portable radiotelephone.

Regarding claim 19, Khello discloses:

in which the secret is encrypted in the memory and the digital device is capable of decrypting the secret (Khello, col. 6, lines 20-30, 47-67; col. 7, lines 17-36).

Regarding claim 20, Khello discloses:

in which the secret is encrypted according to a key provided by the digital device (Khello, col. 7, lines 17-36; col. 8, lines 27-55; Abstract, lines 12-14). Khello discloses that the user authentication service provides the personal communication device with a program for analogously deriving the identical key (thus providing a key) as well as secret encryption algorithms for encrypting the PIN.

Regarding claim 21, Khello discloses:

in which the confirmation comprises the user providing a secret (Khello, col. 6, lines 20-30).

Regarding claim 22, Khello discloses:

in which to request the secret, the digital device is configured to establish contact with the personal communication device and the personal communication device is configured to indicate to the user that a request for a secret has been received (Khello, col. 5, line 57 – col. 8, line 30).

Regarding claims 23 and 24, Khello discloses:

in which the indication comprises providing an audible signal and in which the indication comprises providing a visual signal (Khello, col. 6, lines 20-30).

Regarding claim 25, Khello discloses:

in which the personal communication device is configured whereby upon receipt of the request the personal communication device provides to the user a selection of options of which at least one is to approve the request by selecting the relevant option (Khello, col. 8, lines 20-47; col. 9, lines 50-55). Khello discloses that the personal communication device provides to the user the ability to select one from a plurality of “secrets” (secret encryption algorithms) so as to uniquely encode a PIN and then transmit the PIN to the user authentication center.

Regarding claim 26, Khello discloses:

in which the memory stores a plurality of secrets and the personal communication device is configured to provide a user with plurality of secrets from which to select the secret to be provided to the digital device (Khello, col. 8, lines 20-47; col. 9, lines 50-55). Khello discloses that the personal communication device provides to the user the ability to select one from a plurality of “secrets” (secret encryption algorithms), stored in the device memory, so as to uniquely encode a PIN and then transmit the PIN to the user authentication center.

Regarding claim 29, Khello discloses:

in which the digital device is a non-cellular device (Khello, fig. 1, elem. 20).

Regarding claim 30, Khello discloses:

in which the digital device comprises a modem for communication with the personal communication device (Khello, fig. 1, elem. 18; fig. 4, elem. 48). Khello discloses the digital device as comprising a communication device for receiving telecommunications (a “modem”) from the personal communication device.

Regarding claim 31, it is rejected for the same reason as claim 17, and further because Khello discloses:

the personal communication device is configured to request confirmation from a user that the secret can be provided and provides the secret to the digital device only if the confirmation is provided by the user (Khello, col. 6, lines 20-30). The secret is provided only when the user initiates (“confirms”) the transmission of the secret.

Regarding claim 32, it is rejected for the same reason as claims 17 and 25.

Regarding claims 1 – 10, 13 – 16, 33 – 42, and 45, and 46, they are the method and apparatus claims corresponding to the system claims above, and they are rejected for the same reasons.

Claims 1, 17, and 33 are rejected under 35 U.S.C. 102(a) as being anticipated by Tuneld et al., "Mobile Telephone Auto PC Logon", WO 00/31608.

Regarding claims 1, 17, and 33, they are rejected for the reasons provided by the Search Report (application #GB 0031428.6) conducted on 9/12/2001 as submitted by applicant on 12/21/2001.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11, 12, 27, 28, 43, and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Khello in view of Hayashi et al., "Connection of a Mobile Wireless Terminal to a Host Computer", GB 2,334,682 A.

Regarding claims 27, Khello discloses using a portable radiotelephone for authenticating a user to a remote system. Khello does not disclose that the radiotelephone is a cellular communication device.

Hayashi et al. discloses using a portable radiotelephone for authenticating a user to a remote system. The portable radiotelephone of Hayashi et al. is a cellular communication device (Hayashi et al., fig. 1; page 7, line 14 – page 8, line 3).

It would have been obvious to one of ordinary skill in the art to employ the teaching of using cellular technology with portable radiotelephones of Hayashi et al. with the portable radiotelephone system of Khello. This would have been obvious because one of ordinary skill in the art would have been motivated to enhance the service provided to radiotelephone users as cellular technology would handle simultaneous connections on the same frequencies, accommodate more subscribers than would a single central antenna, provide mobile users with better reception via cell switching, as well as provide numerous other benefits cellular technology has over the older central antenna radio systems.

Thus the combination of Khello and Hayashi et al., discloses:

in which the personal communication device comprises a cellular communication device (Khello, fig. 1, elem. 12; Hayashi et al., fig. 1).

Regarding claim 28, the combination of Khello and Hayashi et al., discloses:

in which the personal communication device comprises a cellular telephone for voice calls (Khello, col. 5, line 57 – col. 6, line 9).

Regarding claims 11, 12, 43, and 44, they are the method and apparatus claims corresponding to the system claims above, and they are rejected for the same reasons.

Response to Arguments

Applicant's arguments filed 9/12/05 have been fully considered but they are not persuasive.

Applicant's argue primarily that:

(i) Regarding Khello (U.S. Patent 5, 724, 423): *It is respectfully submitted that the teachings of this reference fail to establish a prima facie case of anticipation in that the above-mentioned method steps are not disclosed* (Remarks, pg. 12).

Specifically, applicants assert:

- *Inasmuch as the user device requires the PIN to be entered either audibly or manually such as through a key pad, indicates that the PIN is not memorized in the user device* (Remarks, pg. 12).

In response, the examiner respectfully directs the applicant to the rejection of claim 1, wherein it is stated, *Khello discloses the use of memory to store secrets such as a user PIN, encoding keys, and secret encoding algorithms*. Khello clearly discloses the use of memory to store secrets – including keys and secret encoding algorithms.

Art Unit: 2137

Furthermore, the examiner asks – How is it possible for a device to receive a PIN, apply further secrets to the PIN via processing, and re-transmit the PIN without some form of memory means to enable the device to “memorize”, even if temporarily, the very information it is processing? The fact is, Khello discloses a device with memory, enabling the device to store secrets - even if some secrets may be stored temporarily.

- *Further, the fact that the user must initiate encoding and transmission via pressing the END button further highlights the difference between the claimed subject matter and that which is disclosed in the Khello reference (Remarks, pg. 12).*

In response, applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Additionally, applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.

- *In a nutshell, the Khello reference fails to disclose the claimed requirements that the personal communication device requests confirmation from the user that the secret can be permitted to be sent ...*
(Remarks, pg. 12).

In response, the examiner respectfully directs the applicant to the rejection of claim 1 and the cited portions of Khello. Khello discloses that a user is prompted, for the purposes of sending authentication information, to supply authentication information. Such a prompt for information to the user, for the purpose of sending the information, is effectively a request by the device. By consciously volunteering such information, the user is confirming the permission for such information to be sent. Additionally, by requiring the user to actively press a button to initiate the transmission of such information, the device is effectively requesting a confirmation that such information be sent.

- *... and also fails to disclose that the secret per se is initially stored in the communication device* (Remarks, pg. 12).

In response, In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., *initially stored*) are not recited in the rejected claim(s). The applicant's recitation of *a memory in which a secret is stored* (Claim 1) merely suggests

Art Unit: 2137

the presence of a memory in which, at some point in time, a secret is stored. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

(ii) Regarding Tuneld et al. (WO 00/3168): Tuneld does not anticipate claims 1, 17, and 33 under 35 USC § 102, and *it is respectfully submitted that a prima facie case of anticipation has not been established and the rejection is accordingly traversed for at least this reason* (Remarks, pgs. 13, 14).

First, in response to the applicant's argument that a prima facie case of anticipation has not been established, the examiner asserts that a prima facie case of anticipation was indeed established with respect to Khello (U.S. Patent 5, 724, 423). The rejection of claims 1, 17, and 33 under 35 U.S.C. 102(a) as being anticipated by Tuneld et al. was supplied in addition to the prima facie case of anticipation already presented.

Second, the examiner's reference to the document of Tuneld, in its entirety, did not appear to prejudice the applicant from providing substantive arguments pertaining to the prior art. Therefore, evidence is shown that the reference of Tuneld was of an uncomplicated nature, such that material pertaining to anticipation would have been understood by the applicant. Additionally, the examiner presumes that the applicant

Art Unit: 2137

should have received an action corresponding to the Search Report from the UK Patent Office, and would have been able to understand any material still unclear.

In response to the applicant's argument that *...the steps wherein communication is established between the personal communication device and the digital device, which prompts the digital device to request secret information from the personal communication device is not disclosed* (Remarks, pg. 14), the examiner points out that the applicant argues features which are not claimed. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., *communication is established ... which prompts the digital device to request secret information*) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Furthermore, the applicant argues, *the step wherein the personal communication device requests confirmation from the user that the secret information can be permissibly provided to the digital device, is not disclosed, and most certainly the step of providing the secret information only if the confirmation is provided by the user, is not disclosed* (Remarks, pg. 14). In response, the examiner respectfully directs the applicant to review Tuneld (figure 5; page 8, lines 12-20). Tuneld clearly discloses that digital device requests secret information from a personal communication device, the personal communication device prompts a user via a menu to activate the secret

Art Unit: 2137

information sending feature of the personal communication device (thus, confirming permission for the sending of secret information), and the sending of secret information only when permission is confirmed.

(iii) The rejection of claims 11, 12, 27, 28, 43 and 44 under 35 U.S.C. j 103(a) as being unpatentable over Khello in view of Hayashi et al., is respectfully traversed.

These rejections fall with the failure of Khello to anticipate the claims from which claims 11, 12, 27, 28, 43 and 44 depend. In addition, the rejection is untenable in that it is founded on an incorrect understanding of the operation of both Khello and Hayashi et al. vis-à-vis the claimed subject matter (Remarks, pg. 15).

In response, the examiner asserts that Khello anticipates the claims from which claims 11, 12, 27, 28, 43 and 44 depend, and directs the applicant to the reasons supplied above.

Furthermore, the applicant's argument is unpersuasive as the applicant gives no evidence that the examiner demonstrates rejection is *founded on an incorrect understanding of the operation of both Khello and Hayashi et al. vis-à-vis the claimed subject matter.*

Applicant's arguments, see page 12, filed 9/12/05, with respect to the rejection of claims 1, 17, and 33 under 35 U.S.C. 102(b) as being anticipated by Hayashi et al., GB 2,324,682 have been fully considered and are persuasive. The rejection of claims 1, 17, and 33 under 35 U.S.C. 102(b) as being anticipated by Hayashi et al. has been withdrawn.

Applicant's arguments, see page 12, filed 9/12/05, with respect to the rejection of claims 1, 17, and 33 under 35 U.S.C. 102(a) as being anticipated by Kataoka, GB 2,341,061 have been fully considered and are persuasive. The rejection of claims 1, 17, and 33 under 35 U.S.C. 102(a) as being anticipated by Kataoka has been withdrawn.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

Art Unit: 2137

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffery Williams whose telephone number is (571) 272-7965. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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